

### **REMARKS**

The office action of September 10, 2007 raises essentially two issues. First, the office action objects to various claims for informalities. Second, the office action rejects all pending claims as being unpatentable over various references, primarily US Patent No. 6,115,510 to Koga (the "Koga reference").

The applicant has amended the independent claims to incorporate the limitations of various dependent claims. The claims have also been amended to clarify the intended scope.

#### **Claim Objections**

Claims 31, 34, 45, 46, 57, 59, 61, 68, 70, 79, 81 were objected to for informalities in the claim language. The claims have been amended according to the suggestions cited in the office action, and the applicant respectfully submits that the claims are now in condition for allowance.

#### **Rejections Based on Cited References**

Before addressing the merits of the rejections, the applicant submits the following brief description of the patent application. A system according to various aspects of the invention generates copies of documents and electronic images of the documents for later use. The documents are fed into a scanning system, which generates the physical copy as well as the electronic image for storage. In addition, the system stores binding information for the original set of documents, which describes where and how the original documents were bound. For example, the system stores information indicating that pages 1 through 100 were held together with a binder clip, pages 2-8 were stapled together, and page 1 was clipped to pages 2-8 with a paperclip. With this information, not only can the original set of documents be duplicated, but the organization of the original documents may be duplicated as well.

Claims 1, 2, 4, 5, 7, 12, 14, 16-19, 24-30, 32, 35, 36, 39, 40, 42- 44, 47, 48, 51, 53-56, 58, 60, 63-67, 69, 71, 74, 75, 77, 78, 80, and 82 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Koga reference. The applicant respectfully requests reconsideration and review of this application in view of the foregoing amendments and following remarks.

The Koga reference discloses a copy system including a stapler and a sorter. When the copier generates a copy, an image is shown on a CRT with a mark indicating a position for the staple. An operator checks the staple position and either adjusts or accepts it. The stapler staples the printed sheets in the sorter at the designated stapling position(s). The Koga system is designed to prevent the copies from being stapled at a position other than as desired by the operator. Other than processing binding information and making copies, however, the Koga reference has nothing in common with the present application. More specifically, the Koga system does not store electronic images of the full set of documents in long-term memory. The Koga system does not store binding information for the original series of documents, and fails to store a sequence location for a binding element in the series of documents.

To the extent understood, the office action suggests that the CPU 240 and the unrepresented registers storing staple position information provide the claimed control system. As amended, claim 1 calls for a scanner and a control system. The scanner prints copies of a series of documents and generates electronic images of the documents. The control system stores the electronic images in long-term memory. The control system also stores binding information for the series of documents. The binding information includes a sequence location of a binding element and/or the type of the binding element.

To support a rejection under § 102, a prior art reference must disclose each and every element and limitation in the rejected claim. Omission of any claimed element or limitation, no matter how insubstantial, is grounds for traversing a rejection based on §102.

Unlike the claimed system, the Koga system fails to store binding information images in long-term memory. The Koga reference stores the image and the binding information long enough to perform the stapling job at the desired location, but does not disclose retaining binding information and the images in long-term memory for later retrieval. In contrast, the claimed invention stores the images and the binding information in long-term memory for later use. Consequently, the original series of documents can be reconstructed from the information stored by the claimed system. The Koga system does not offer this capability.

In addition, the Koga reference teaches away from the claimed invention. The Koga reference “stores” the image only long enough to facilitate designating the correct staple location. Retaining the image any longer would require additional expensive memory, as the function of the Koga reference (i.e., generating a copy with staples in proper locations) is complete. The brief transitional retention of the document image long enough to print the image and represent it on the display as disclosed in the Koga reference does not disclose the claimed invention.

Further, the Koga reference does not store binding information for the series of documents, i.e., the original set of documents. Instead, the Koga reference allows the operator to select a position for the staple, which is selected according to the operator’s desire, not according to the original series of documents. Thus, the Koga reference uses binding information based on the operator’s selection, not the original set of documents to be copied. Again, this permits the original series of documents to be reconstructed from the information stored by the claimed system. The Koga system does not offer this capability.

Moreover, the Koga references does not store binding information comprising either a sequence location of a binding element in the series of documents or a type of the binding element the sequence location. In the Koga reference, the binding element is always a staple, and the location is the location on a page (i.e., left/right or up/down), not the point in a sequence (i.e., third page through eight page) as claimed.

In rejecting claims 4, the limitations of which have been incorporated into claims 1, the office action asserted that the Koga reference discloses the claimed control system as the CPU 240 and the registers. Registers, however, are short-term memory. As described above, the Koga reference fails to disclose storing the images and the binding information in long-term memory, which facilitates later reconstruction of the original series of documents.

The other independent claims have been amended and include similar limitations absent from the Koga reference. More specifically, claim 12 requires storing binding information and descriptive data for the original collection of documents in long-term memory. The control system of claim 24 stores binding information and organization data pertaining to the original set of documents in long-term memory. Claim 39 requires the control system to store organizational data, including binding information, image range information, and description information, and the images in a long-term memory. Claim 51 requires the computer system to store organizational data regarding a set of images, including binding information, image range information, and description information, and the image data in a long-term memory. Claim 63 requires the program to store organizational data regarding a set of images, including binding information, image range information, and description information, and the image data in a long-term memory. Claim 74 also calls for storing organizational data regarding a set of images, including binding information, image range information, and description information, and the image data in a long-term memory. The elements and limitations are not disclosed in the Koga reference, and the rejections of the claims under § 102 should therefore be withdrawn.

The office action rejects each claim in the application based on the Koga reference. Because the Koga reference fails to disclose express elements of the claimed invention of each of the independent claims, however, the rejections should be withdrawn. The applicant thus respectfully requests reconsideration and withdrawal of the rejections for all claims.

With regard to the specific dependent claims, the Koga reference fails to disclose various express elements and limitations, and the office action fails to provide any support for the rejections. For example:

- Claim 5 requires an interface displaying multiple binding element types for selection. To the extent understood, the office action asserts that in the Koga reference, a binding element is considered the stapler, and Figure 12 shows several types of staplers. This is incorrect because the office action ignores the definition of “binding element type” provided in the specification (paragraph 0041), which does not include different “types of staplers”. Staples are a single binding element type. Figure 12 of the Koga reference shows different staple placements, not different types of staples or other binding elements.
- Claim 14 requires the storage location for the electronic images to be a selectively changeable default location. The office action notes that the Koga reference discloses memory locations, but identifies no disclosure regarding the “selectively changeable” limitation.
- Claims 60 and 82 require the claimed computer system and method to selectively display the images and the organizational data. The Koga reference discloses automatically displaying the preview image of the document, not selectively.

#### Obviousness Rejections

Various other claims stand rejected under 35 U.S.C. § 103(a) as being obvious in view of multiple references. Obviousness is determined according to (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the prior art and the claimed invention, and (4) the extent of any objective indicia of nonobviousness. In this instance, a system that automatically generates and inserts a reference numbers to the scanned images is not disclosed in the prior art references, and the claimed differences are not taught or suggested by the cited prior art references.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done, and cannot rely on the applicant's disclosure. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. In the recent Supreme Court decision in *KSR v. Teleflex*, the Court notes that "a patent composed of several elements is not proved obvious by merely demonstrating that each of its elements was, independently, known in the prior art." *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Additionally, the Court cited *In re Kahn* stating that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*

In the instant case, the combination of the Koga reference and the other cited references does not render the claimed invention obvious. As discussed, the Koga reference fails to disclose several elements and limitations in the independent claims, and the cited references also fail to disclose these features. Consequently, the applicant respectfully submits that rejections are improper and should be withdrawn. Further, the office action fails to fulfill the prima facie obviousness requirements as described above, and the applicant respectfully submits that the rejections under § 102(a) should be withdrawn.

#### The Koga and Jiang References

Claims 8, 9, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koga in view of Jiang (US Pub. No. 2005/0040642). The Office Action states that the Koga reference:

discloses a system for making images according to claim 1, further comprising a control system connected to the scanner (i.e. in the system of Koga '510, the scanner in the copier is connected to CPU (240), which controls a plurality of

functions in the copy machine.....However, Koga '510 fails to teach wherein the control system is configured to insert reference numbers into the electronic images. However, this is well known in the art as evidenced by Jiang '642. Jiang '642 discloses wherein the control system is configured to insert reference numbers into the electronic images (i.e. shown in figure 1, the steps of performing the insertion of a reference number, or Bates number occurs. A number is attached to an image and is then scanned. The Bates number is now inserted into the electronic image that is generated by the scanning system.).

Claims 8 and 20 have been amended to clarify the limitation of automatically generating and inserting a reference number. Upon review of the Jiang reference, the concept of adding reference numbers to the scanned images requires the manual step of affixing a reference number to the image prior to scanning. Jiang does not disclose automatically generating and inserting the reference numbers into the scanned image by the control system. On the contrary, the Jiang reference clearly underscores the need for the claimed invention.

#### The Koga and Murata References

Claims 10, 11, 22, 23, 37, 37, 49, 50, 61, 62, 72, 73, 83, and 84 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koga in view of Murata (US Pub. No. 2003/0086120). The Office Action states that Koga

discloses a system for making images according to claim 1, further comprising a recording system connected to the scanner...wherein the recording system is configured to record the images on a medium...and store a viewer program on the medium.....However Koga '510 fails to teach store a viewer program on the medium. However, this is well known in the art as evidenced by Murata '120. Murata '120 discloses store a viewer program on the medium (i.e. Koga '510 appears not to teach storing both image data and a control program on the same medium. In Murata '120, a storage medium is used to store both image data and control data that is a program that allows a user to use the image reader in the

system from the personal computer. The feature of Murata '120 enable the user to both control a program and image data on a storage medium....Therefore, in view of Murata '120, it would have been obvious to one of ordinary skill at the time the invention was made to store a viewer program on the medium in order to store both control data and image data on a storage medium.

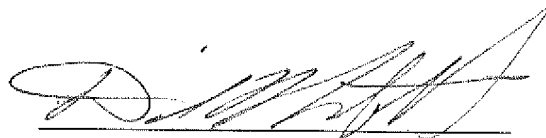
The applicant traverses this position. The combination of the Koga and Murata references does not render the claimed invention obvious because the office action provides no valid reason why a person of ordinary skill in the art would combine the references to arrive at the claimed invention. The Koga system only briefly stores the images in a local memory, and already has the viewer equipment available. Thus, there would no reason to store a viewer program in the "medium" of the local memory. Because the Office Action fails to fulfill the prima facie obviousness requirements, the applicant respectfully submits that the rejections of Claims 10, 11, 22, 23, 37, 37, 49, 50, 61, 62, 72, 73, 83, and 84 should be withdrawn.

### CONCLUSION

Please consider the amendments and remarks. In view of the present amendments and comments, the applicant respectfully submits that the claims are in condition for allowance. Please contact the undersigned attorney at the address and telephone number noted below with any questions or comments.

Respectfully submitted,

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